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Proceeding	85690391
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**UNITED STATES PATENT AND TRADEMARK OFFICE  
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Applicant:      Foamation Inc.

Mark:



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**APPLICANT'S REPLY BRIEF**

In her Appeal Brief filed with the Board on June 18, 2015 (“Examiner’s Brief”), the Examining Attorney maintains that Applicant is trying to register a configuration mark. All of her supporting arguments are incorrect.

1.      The Examining Attorney incorrectly argued that Applicant’s mark cannot be separated from the configuration of its products.

The Examining Attorney states throughout her brief that Applicant’s applied-for mark, which is comprised of the color yellow/gold and a pattern of pock marks, is inseparable from overall shape of its various goods:

[T]he foam is incorporated into the goods in such a manner that it is not capable of standing out on its own as a perceptible mark. Rather, only when the foam is shaped into the individual products does a perceptible mark emerge, thus creating distinct configuration marks.

In short, the “mark” (i.e., the foam) is inseparable from the goods themselves. It follows that the use of the cheese-shaped foam in the drawing to make the disparate goods identified in the application creates distinct and different marks. Thus, Applicant’s foam is no more separable from the items it is formed into than a penguin design is separable from the cocktail shaker that is shaped like a penguin.

Applicant’s mark is a configuration mark constituting product design for two reasons. First, the design feature is not separable from the goods, but rather an integral component.

Thus, it is the fact that the cup holder, tie or hat is shaped like cheese that renders the items desirable....

Applicant may not separate the color and pattern from the three-dimensional cheese configuration as these elements are fused together in the mind of the consumer.

What is patently obvious is that the foam shown in the drawing is formed into the resulting cheese-shaped product....

Examiner's Brief at 6, 7, 9. Applicant's goods are not shaped like cheese, and thus Applicant's mark can be separated from each product configuration and is in no way analogous to the penguin-shaped cocktail shaker in *Wal-Mart Stores, Inc. v. Samara Bros.* Applicant directs the Board to pages to 2-4 of its Supplemental Appeal Brief, filed April 21, 2015 ("Applicant's Brief"), where Applicant highlighted the shapes of its belt, tie, Christmas tree ornament, and football. The shapes do not resemble cheese. They are not wedges, slices, bricks, wheels, or any other common cheese shape. They are shaped like every day belts, ties, ornaments, and footballs. This clearly demonstrates that it is not the 3D configuration of Applicant's products that creates its mark and unique product appearance, but only the surface color and texture combination. This image of Applicant's mark also illustrates its point:



It is not configured into a particular shape yet has the appearance of cheese. Applicant's mark is entirely independent of its product configurations. The Examining Attorney's arguments to the contrary are wrong.

2. The Examining Attorney incorrectly argued that because Applicant's mark is embedded in the material composing goods it is necessarily a product configuration.

The Examining Attorney states in her brief that Applicant is trying to protect the foam that composes its goods:

Applicant seeks to trademark the foam material it uses to make assorted novelty items, thus the material composing the *whole* of the goods.

In short, the "mark" (i.e., the foam) is inseparable from the goods themselves.

Examiner's Brief at 6, 7. Applicant is not seeking trademark protection for foam. It seeks to register the color and texture combination on the foam. Contrary to the Examining Attorney argument, it does not matter that the color and texture combination is not "flat" and is embedded in the surface of the foam:

The second reason the mark is a configuration mark is that it has obvious characteristics that are three- dimensional. When viewing use on the specimens, one can easily see the three-dimensional contours, holes and pock marks that are part of the foam material in the drawing. These are not flat patterns or textures attached to existing products like the handbags in Applicant's evidence.

*Id.* at 7-8. Applicant explained that the USPTO has granted many registrations for marks embedded in and part of the material that composes the registrants' products. Applicant's Brief at 6-12.

Applicant's mark should not be treated any differently.

3. The Examining Attorney incorrectly argued that because consumers desire the "cheese" look of Applicant's goods, that somehow necessarily renders the appearance a product configuration mark.

The Examining Attorney suggests throughout her brief that because the look of Applicant's goods makes them desirable, that somehow renders Applicant's mark a 3D product configuration:

Clearly, Applicant's mark is not merely a colored pattern that is applied to the surface of goods and would not be perceived so by consumers, who only purchase these items because they look as if they are made of cheese.

This feature of the design is meant to appeal to a certain target audience. In other words, it is the fanciful design that makes the goods desirable.

The juxtaposition of utilitarian items with the cheese-shaped foam material alters the impression of the entire product, transforming an ordinary item into a novelty item that is desirable to a specific consumer.

Thus, it is the fact that the cup holder, tie or hat is shaped like cheese that renders the items desirable, as these novelties are marketed to Green Bay Packer sports fans known as "Cheeseheads." *See Specimens* at p. 3 that states the goods are "for extreme Cheesehead fans" and provides "Green Bay Packer Links." Applicant's specimen touts desirability of the novelty configuration in the display for the goods, in particular, the fact that sports fans can order various goods made from the foam.

Examiner's Brief at 7, 9. There is no support for this argument. That consumers desire a product based on its look does not render its appearance a product configuration. Consumers desire Louis Vuitton's "Epi" leather products based on their appearance and the "Epi" leather design is protected by swatch, not product configuration, registrations. Applicant's Brief at 4-7.

4. The Examining Attorney incorrectly argued that Applicant's third-party evidence is unpersuasive.

The Examining Attorney said the following about Applicant's third-party registration evidence:

Applicant's examples of third party registrations do not support the contention that its mark is not a configuration mark. Many of the cited marks are ornamental or nondistinctive background matter marks registered with Section 2(f) claims, for instance U.S. Reg. Nos. 1323310, 4104123 and 3009490. Others, such as U.S. Reg. Nos. 2946953 and 1924891, are nondistinctive ornamental features registered on the Supplemental Register. Still others are actually configuration marks appropriately registered with Section 2(f) claims, including U.S. Reg. Nos. 1413427 and 2236976 according to the mark descriptions.

Examiner's Brief at 10. It is irrelevant that these registrations include 2(f) claims or are on the Supplemental Register. They are non-configuration registrations (i.e., the overall shape of the product is not part of the registered mark) for textured patterns that, like Applicant's mark, are embedded in the materials that compose the goods. Applicant's Brief at 7-12.

The Examining Attorney goes on to say that the Louis Vuitton "Epi" leather registrations are distinguishable:

And, the "Epi" leather examples from the Louis Vuitton marks are clearly distinguishable, as the pattern does not alter the nature of the product in the same manner as Applicant's foam, which turns its goods into cheese-formed novelty items for Green Bay Packer fans. Furthermore, in none of the examples are there myriad disparate goods identified by the cited marks. Finally, none of the examples Applicant cites present the material composition of the goods as a trademark, where the whole of the goods are constructed from the material indicated in the drawing.

Examiner's Brief at 11. None of her points have support. First, Applicant's mark does not alter its products any differently than the Louis Vuitton "Epi" pattern – Applicant's mark gives its goods a cheese appearance that makes its goods desirable to Applicant's target market (Wisconsin sport fans) while Louis Vuitton's "Epi" pattern likewise gives its products a particular appearance that makes them desirable to Louis Vuitton's target market (purchasers of luxury leather products). Second, that Applicant offers a wider variety of goods than Louis Vuitton is irrelevant; the Examining Attorney cites no legal authority for that argument. Finally, Applicant showed that the whole of Louis Vuitton's goods are indeed constructed from the textured material in the "Epi" registration drawings. Applicant's Brief at 6-7.

## 5. Other Arguments

Since the Examining Attorney's understanding of Applicant's mark is incorrect, so too are her amended drawing, amended mark description, and substitute specimen requirements, which must be withdrawn. Therefore, there is no need for Applicant to reply to her arguments on these points.

Nor is Applicant responding to the Examining Attorney's arguments about the distinctiveness of its mark because only when the Board rules that its applied-for design can function as a trademark independent of its product configurations can Applicant demonstrate the mark's distinctiveness.

Respectfully submitted,

**FOAMATION INC.**

By its Attorneys,

Date: June 24, 2015

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**CERTIFICATE OF TRANSMISSION**

I hereby certify that on June 24, 2015, Applicant's Reply Brief was filed electronically with the Trademark Trial and Appeal Board.

/Laura M. Konkel/

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